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Docket No. CITI0227

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the U.S. Application of:

Luke CHU, et al.

Group Art Unit: 2165

Serial No.: 09/885,674

Examiner: To Be Assigned

Filed: June 20, 2001

For: SYSTEM AND METHOD FOR ADMINISTRATION OF NETWORK
FINANCIAL TRANSACTION TERMINALS

PETITION UNDER 37 C.F.R. §1.47(a)

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Commissioner for Patents
Washington, D.C. 20231

Sir:

The Applicant hereby petitions under 37 C.F.R. §1.47(a) to proceed without Mr. Mark Sullivan, one of the inventors in this application, because Mr. Sullivan refuses to join and sign the needed declaration. In support of this Petition, the following is submitted herewith.

1. A Declaration of Facts by George T. Marcou regarding Mr. Sullivan's refusal to sign and join in this application and evidencing the need to file without Mr. Sullivan's signature in order to prevent irreparable damage and to preserve the rights of the parties, said Declaration including the following Exhibits:

A. A redacted version of the Temporary Technical Services Agreement between Citicorp Development Center, Inc. and Quantum Technical Solutions (employer of Mark Sullivan at the time of inception of the invention).

B. A copy of a letter sent via Federal Express, to Mr. Sullivan on January 11, 2002 forwarding the Declaration, a copy of the application as filed, other documentation

for his signature, and requesting that he execute the necessary documentation for filing and return them to us in the Federal Express package provided;

C. A copy of the Federal Express receipt showing receipt of the package on January 14, 2002;

2. The last known address of Mr. Sullivan is set forth in the attached Declaration of Facts by George Marcou;

3. The combined Declaration/Power of Attorney signed by the remaining inventor under 37 C.F.R. §1.47(a) is submitted herewith; and

4. The fee in the amount of \$130.00 for this Petition Under 37 C.F.R. §1.47(a) is included herewith.

In view of the foregoing, it is respectfully submitted that Mr. Sullivan has clearly received the application papers and has refused to sign. It is, thus, most respectfully requested that the Patent Office grant this Petition Under 37 C.F.R. §1.47(a).

Early consideration and granting of this petition is most respectfully requested. The Patent Office is encouraged to contact the undersigned in the event that the Patent Office desires to discuss any aspect of this invention. In the event that any fees are due in connection with this submission, please charge and/or credit our Deposit Account number 501458.

Respectfully submitted,

DATE: 2/12/02


George T. Marcou

Registration No. 33,014

KILPATRICK STOCKTON LLP
607 14th Street, N.W., Suite 900
Washington, D.C. 20005
(202) 508-5846

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the U.S. Application of:

Luke CHU, et al.

Group Art Unit: 2165

Serial No.: 09/885,674

Examiner: To Be Assigned

Filed: June 20, 2001

For: SYSTEM AND METHOD FOR ADMINISTRATION OF NETWORK
FINANCIAL TRANSACTION TERMINALS

DECLARATION OF FACTS UNDER 37 C.F.R. §1.47(a)

Commissioner for Patents
Office of Petitions
Washington, D.C. 20231

Sir:

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1. This declaration is submitted in support of the accompanying Petition Under 37 C.F.R. §1.47(a).
2. Mr. Mark Sullivan, a named inventor, has refused to join in the present application and sign the needed declaration.
3. I have made diligent efforts to obtain the signature of Mr. Sullivan on the needed declaration, power of attorney, and other documentation in the above-identified application. Nevertheless, Mr. Sullivan refuses to so join and sign. Upon information and belief, Mr. Sullivan no longer works with the consulting company (Quantum Technical Solutions) contracted by the assignee of this invention and application, Citicorp Development Center, Inc. A redacted version of the Temporary Technical Services Agreement between Citicorp Development Center, Inc. and Quantum Technical Solutions is attached (see Exhibit A) wherein it states (page 6, Paragraph 10) that all discoveries, inventions, etc., “. . . shall be the sole and exclusive property of CDC . . .”
4. On January 11, 2002, Jeanne Paoletta-Bald (Paralegal) of our office contacted Quantum Technical Solutions to determine whether Mr. Sullivan was still employed or, if not, what information, if any, they had for Mr. Sullivan. No new information was received from Quantum Technical Solutions.

5. On January 11, 2002, I sent a letter to Mr. Sullivan by Federal Express forwarding a copy of the declaration, a copy of the application as filed, and other documentation and requesting that he execute the necessary documentation for filing and return to me in the Federal Express envelope provided to him (see Exhibit B). Mr. Sullivan signed for the package on January 14, 2002 (see Exhibit C), and Mr. Sullivan did not respond to our request.

6. Filing of the above-identified application without Mr. Sullivan's signature is necessary to preserve the rights of the parties and to prevent irreparable damage. A response to the Notice to File the missing Parts for the application is due with a four-month extension of time by February 16, 2002. Failure to grant this petition may result in the Patent and Trademark Office deeming the application abandoned, thus irreparably harming the assignee, Citicorp Development Center, Inc.

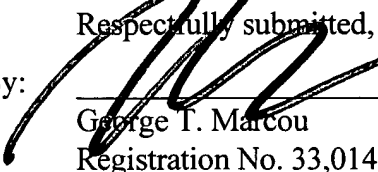
7. Mr. Sullivan's last known mailing address is:

Mr. Mark Sullivan
827 Marco Place
Venice, CA 90291

8. On information and belief, Mr. Mark Sullivan was a former employee of Quantum Technical Solutions, a consulting firm contracted by Citicorp Development Center, Inc.

9. I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true and further that the statements are made with the knowledge that willful statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements jeopardize the validity of the application or any patent issuing thereon.

Date: 2/12/02
KILPATRICK STOCKTON LLP
607 14th Street, N.W., Suite 900
Washington, D.C. 20005
(202) 508-5846
T0091/203881/WSHLIB01:84170

Respectfully submitted,
By: 
George T. Marcou
Registration No. 33,014

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TEMPORARY TECHNICAL SERVICES AGREEMENT

This Agreement is made and effective as of April 1, 1997 by and between **Quantum Technical Solutions** ("the Agency"), an Independent Contractor, having a principal place of business at 12340 Santa Monica Blvd., Suite 304, Los Angeles, CA 90025, and **Citicorp Development Center, Inc.** ("CDC"), organized and existing under the laws of the State of Delaware, with a principal office 12731 W. Jefferson Blvd., Los Angeles, CA 90066.

10. **PROPRIETARY RIGHTS**

(a) Ownership of Inventions and Copyrights. Agency hereby agrees that all inventions, discoveries, improvements, designs, methods, devices, systems, computer software, writings, compilations of information, and/or materials that are protectable as intellectual property in the United States, whether under the laws of patents, copyrights, and/or trade secrets, (hereinafter referred to in the aggregate as "Inventions and Copyrights") that are conceived, designed, practiced, prepared, or developed by it, either alone or in concert with others,

- (1) in the course of its engagement to CDC hereunder,
- (2) based upon knowledge or information learned or gained from CDC, or
- (3) that results from the use of CDC's facilities, personnel, or materials,

are and shall be the sole and exclusive property of CDC, unless identified in a list attached hereto as Inventions and Copyrights made and/or owned by Agency prior to its engagement hereunder that Agency intends to, or may, utilize in connection with the specific task(s) and/or problem(s) assigned to it hereunder (hereinafter referred to as "Pre-existing Inventions and Copyrights"). If no such list is attached, there are no such Pre-existing Inventions and Copyrights, unless the parties have both executed a separate (unattached) list identifying such Pre-existing Inventions and Copyrights.

(b) Post-Term Inventions and Copyrights. Agency further agrees that all Inventions and Copyrights reduced to practice, or otherwise made by it, either alone or in concert with others within one (1) year immediately following the end of the term of its engagement by CDC, which Inventions and Copyrights are reasonably within the scope of its engagement hereunder or related to knowledge and information learned or developed during said engagement, shall be presumed to have been conceived in the course of said engagement and, therefore, to be the sole and exclusive property of CDC. The foregoing presumption, however, may be overcome by Agency by the production of tangible evidence tending to show clearly that

any such Inventions and Copyrights were conceived after the expiration or termination of its engagement by CDC under this Agreement or any extension(s) hereof.

(c) Disclosure of Inventions and Copyrights. Agency hereby agrees to communicate and disclose promptly to CDC all Inventions and Copyrights made during the term of its engagement by CDC and during said one-year period immediately following the expiration or termination of such engagement. Moreover, Agency further agrees to safeguard the confidentiality and proprietary nature of any and all such Inventions and Copyrights in the same manner as that prescribed in Article 11 herein for the treatment of CDC's Confidential and Proprietary Information.

(d) Assignment. Agency hereby agrees that such Inventions and Copyrights are assigned to CDC and that it will execute all papers necessary to assign and transfer to CDC, or its nominees, successors, or assigns, free of encumbrances, all rights, title, and interest in and to all Inventions and Copyrights within the scope of Articles 10(a) or 10(b) hereof. All such assignments shall include existing or prospective patent right and copyrights in the United States and all foreign countries.

(e) License to Use Pre-existing Inventions and Copyrights. If Agency has Pre-existing Inventions and Copyrights that are identified pursuant to the provisions of Article 10(a) immediately above, and if Agency has used, or intends to use, such Pre-existing Inventions and Copyrights, or any portion thereof, in connection with solving any problem(s) and/or performing any tasks(s) assigned hereunder, Agency hereby represents and warrants that:

- (1) it is the sole and exclusive owner of such Pre-existing Inventions and Copyrights; and
- (2) it has the right to utilize the same for the benefit of CDC as aforesaid; and
- (3) all Inventions and Copyrights developed under this Agreement shall be the Agency's own work.

Moreover, if any of Agency's Pre-existing Inventions and Copyrights are used in connection with the solution of any problem(s) and/or the performance of any task(s) assigned to Agency hereunder, Agency hereby grants to CDC a non-exclusive, royalty-free, worldwide, transferable right and license to use such Pre-existing Inventions and Copyrights in the same manner and for the same purpose as Agency used the same, thereby ensuring to CDC the legal right and ability to make, use, reproduce, and/or sell products or services that incorporate or utilize such Pre-existing Inventions and Copyrights in the manner designed or prescribed by Agency.

(f) Patents and Copyrights.

- (1) Execution of Applications. Agency hereby agrees to execute all instruments, oaths, declarations, or other papers required to be filed with any applications for Letters Patent or applications for the registration of copyrights that CDC desires to file in the United States or in foreign countries, provided that the subject matter of such applications includes Inventions and Copyrights made by Agency within the scope of Articles 10(a) or 10(b) hereof.
- (2) Cooperation. Agency further agrees to supply all information to and cooperate with CDC with respect to the filing and prosecution of all applications for Letters Patent and applications for the registration of copyrights in the United States and in foreign countries. Agency further agrees to do all other lawful acts that are reasonably necessary in respect to such applications without expense to itself or charge to CDC. All items provided to CDC which qualify as CDC property shall be marked as follows:

© 199x Citicorp Development Center, Inc.

- (g) The Agency shall ensure that each Temporary Technical Service Provider assigned to perform Services signs the Loan-Out Employee Agreement, Appendix C, which is attached hereto and made a part hereof prior to beginning an assignment. The Agency shall forward to CDC's Contract Representative identified in Section 16 of this Agreement the executed copy of this Loan-Out

REDACTED VERSION

CDC CONFIDENTIAL

Employee Agreement for CDC's records prior to assigning the Temporary Technical Service Provider to perform Services.

IN WITNESS WHEREOF, the parties hereto, through their duly authorized officers, have executed this Agreement as of the day and year first set forth below.

The Agency

Citicorp Development Center, Inc.

Accepted By: *Steven M. Sobel*

Accepted By: *Mark Tremayne* 4/1/97

Print Name: STEVEN M. SOBEL

Print Name: Mark Tremayne

Title: Dir. of OPERATIONS

Title: Director of Purchasing

Date: 4-2-97

Date: _____

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January 11, 2002

direct dial 202 508 5846
GMarcou@KilpatrickStockton.com

VIA FEDERAL EXPRESS

CONFIDENTIAL

Mr. Mark Sullivan
827 Marco Place
Venice, CA 90291

Re: U. S. Application Serial No. 09/885,674
Filing Date: June 20, 2001
For: "SYSTEM AND METHOD FOR ADMINISTRATION OF
NETWORK FINANCIAL TRANSACTION TERMINALS"
Our Ref.: T0091/203881 (CITI0227)

Dear Mr. Sullivan:

I represent Citicorp Development Center, Inc. in the above-identified application, and enclosed is a copy of Assignment and Declaration forms and the application as filed. Please review the **confidential copy** of the application and sign and date the Assignment and Declaration forms in the places shown and return the executed forms to me in the enclosed Federal Express envelope. Please return these documents to me by January 21, 2002 so that we may respond to a filing deadline imposed by the Patent and Trademark Office.

The confidential application (copy enclosed) was filed on June 20, 2001.

If you have any questions, please contact me at 202-508-5846.

Best regards.

Very truly yours,

George T. Marcou

Enclosures

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Address _____

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 Recipient's
Name George T. Marcou Phone (202) 508-5800

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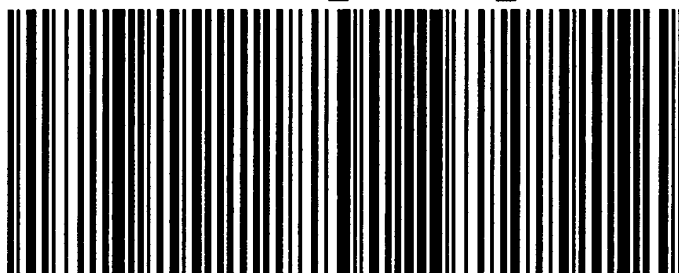
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